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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/976,799

10/12/2001

Robert J. Greenberg

S100-DIV1

4191

28284 7590 01/12/2007  
SECOND SIGHT MEDICAL PRODUCTS, INC.  
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EXAMINER

OROPEZA, FRANCES P

ART UNIT

PAPER NUMBER

3766

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/12/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No. -

09/976,799

Applicant(s)

GREENBERG ET AL.

Examiner

Frances P. Oropeza

Art Unit

3766

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/24/06 (Amendment B).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 269-314 is/are pending in the application.
- 4a) Of the above claim(s) 275,278-282,286-288 and 297-314 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 269-271,276,277,283-285,289-291,295 and 296 is/are rejected.
- 7) ☒ Claim(s) 272-274 and 292-294 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Restriction***

1. Newly submitted claims 310- 314 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the originally claimed invention is a device, a visual prosthesis. The new claims are directed to a distinct invention, a method of making an implanted device.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 310-314 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Response***

2. The Applicant amended the claims and withdrew claims in the response filed 10/24/06, hence the rejection of record is withdrawn and a new rejection established in the subsequent paragraphs. In the response filed 10/24/06, the Applicant withdrew claims 275, 278-282, 286-288 and 297-309 from prosecution.

### ***Claim Rejections - 35 USC § 112***

3. Claim 277 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Claim 277 depends on a canceled claim. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. Claims 269, 270, 276, 283, 284, 285, 289, 290 and 296 are rejected under 35 U.S.C. 102(b) as being anticipated by de Juan, Jr. et al. (US 5109844). De Juan, Jr. et al. disclose a retinal micro-stimulator. The thin film/ hermetic box is read to be the low temperature surface oxide deposition formed over the silicon wafer and electronics (figure 7; col. 4 @ 66 – col. 5 @ 36). Based on figure 7, the visual prosthetic is centered in the vitreous humor.

In the response filed 1024/06, the Applicant argues that the coating taught by de Juan, Jr. et al. is not hermetic. It appears the Applicant intended to solidify this argument by submitting a declaration from Dr. Dao Min Zhou, but no such declaration was filed. De Juan, Jr. et al. teach the use of a surface oxide deposition step to protect against body fluids (col. 5 @ 26-31), read to be the creation of a hermetic seal. The rejection of record stands.

***Claim Rejections - 35 USC § 103***

5. Claims 271 and 291 are rejected under 35 U.S.C. 103(a) as being unpatentable over de Juan, Jr. et al. (US 5109844) in view of Schulman et al. (US 6259937). As discussed in paragraph 4 of this action, de Juan, Jr. et al. disclose the claimed invention except for the hermetic box being metal and ceramic.

Schulman et al. teach implantable device coatings using: a combination of metal and ceramic (col. 9 @ 62-64; col. 10 @ 48-51) for the purpose of providing an effectively hermetic seal to protect the feed-through and other portions of the device from damage when exposed to bodily fluids (col. 7 @ 7-19). It would have been obvious to one having ordinary skill in the art

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at the time of the invention to have used the proven barriers that are a combination of metal and ceramic in the de Juan, Jr. et al. system in order to avoid damaging the device components, making the device inoperable (col. 2 @ 9-14).

6. Claims 277 and 295 are rejected under 35 U.S.C. 103(a) as being unpatentable over de Juan, Jr. et al. (US 5109844) in view of Davidson (US 5683442). As discussed in paragraph 4 of this action, de Juan, Jr. et al. discloses the claimed invention except for the film being a diamond/ diamond-like coating/ film.

Davidson teaches coatings on body implants using a film/ coating that is a diamond/ diamond-like coating (col. 3 @ 46-56) for the purpose of providing a toxin free material that is wear resistant and bio-compatible as a material of construction for the body implant. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used the proven films of a diamond/ diamond-like coating/ film in the de Juan, Jr. et al. system in order to avoid blood clots caused by non optimum materials and to avoid catastrophic failure of the implanted device (col. 1 @ 21-27 and 59-61; col. 2 @ 3-10 and 35-39).

***Allowable Subject Matter***

7. Claims 272-274 and 292-294 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Drawings*

8. The objection against figure 1b stands because the Examiner is unable to find the reference numeral (20), (103) and (119) of figure 1b in the specification. Appropriate correction is required.

*Specification*

9. The objections against the specification stand because figures 16a and 16b are unclear. The specification does not define the reference numerals 1601-1605, 1610 and 1611 shown in the figures 16a and 16b. Appropriate correction is required.

*Statutory Basis*

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fran Oropeza whose telephone number is (571) 272-4953. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communication and for After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frances P. Oropeza  
Patent Examiner  
Art Unit 3766

*FPO*  
*1/4/07*

  
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